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ANTHONY R. BARKUME  
20 GATEWAY LANE  
MANORVILLE,, NY 11949

EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/648,705

Applicant(s)

POSTREL, RICHARD

Examiner

Susanna M. Diaz

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- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 30-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 30-76 are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 30-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear which of the user's "reward point accounts" (from line 5) is being referred to by "the reward point account" in line 11 of claim 30.

It is not clear which of the "reward points issuing entities" (from lines 13-14) is being referred to by "the reward points issuing entity" in line 16 of claim 30.

It is not clear which of the user's "reward point accounts" (from lines 7 and 8) is being referred to by "the reward point account" in line 14 of claim 54.

Claim 54 recites various functionality that is not expressly performed by an element of the system; therefore, it is not clear that the functionality in question merits patentable weight in claim 54. For example, it is not clear which specific system element performs the functionality in (iii)(1), (iii)(2), and the whereby clause recited in the last seven lines of the claim.

Claim 70 is a system claim; however, it is dependent from method claim 48. For examination purposes, it will be assumed that claim 70 is dependent from system claim 54 instead.

Claims 31-53 and 55-76 are dependent from claims 30 and 54, respectively, and therefore inherit the same rejections under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 30-32, 35-38, 41, 43-52, 54-56, 58-61, 64, 66-69, and 71-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over the MyPoints™ Program, as disclosed in the following references:

Information about the MyPoints™ Program retrieved on July 26, 2002 from Internet <URL:<http://web.archive.org/web/19980128231040/http://www.mypoints.com>>, herein referred to as MyPoints™ Program web site. This web site was archived by web.archive.org on January 28, 1998.

Oberndorf, "Points for Loyalty," published December 1997.

Riedman, "MyPoints Aims to Be Universal Web Currency," published August 18, 1997.

Regarding claims 30-32, 35-38, 41, and 43-52, MyPoints™ discloses a method of operating a reward points accumulation and redemption program comprising the steps of:

a user earning reward points from a plurality of reward points issuing entities, each of said reward points issuing entities tracking the user's earned reward points in a user reward point account (MyPoints™ Program web site: Page 1 – Points are collected from different sources, on and off the Internet, and combined into one universal account; Pages 7-8 – Each web site decides how many points to offer to a user. Points may be provided either on- or off-line and are processed overnight to be posted to the universal account on the following day in order to avoid fraudulent activity. This means that the points issued by the participant sites must be tracked at least long enough, e.g., in a user reward account, to transfer this earned reward points information to the user's universal account on the MyPoints™ server, i.e., the trading server; "Points for Loyalty": ¶ 6 – Issuing catalogers, i.e., reward points issuing entities, purchase points from MyPoints; therefore, they must maintain a balance of purchased points in order to account for how many reward points they possess to offer to users and to reconcile those already rewarded. This is especially important in order to reconcile points granted for off-line activities);

a trading server accumulating the user's earned reward points from each of said reward servers interconnected over a network in association with consideration provided by said reward servers to the trading server and crediting said accumulated points into a reward exchange account associated with the user (MyPoints™ Program

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web site: Page 1 – Points are collected from different sources, on and off the Internet, and combined into one universal account; Pages 7-8 – Each web site decides how many points to offer to a user. Points may be provided either on- or off-line and are processed overnight to be posted to the universal account on the following day in order to avoid fraudulent activity. This means that the points issued by the participant sites must be tracked at least long enough, e.g., in a user reward account, to transfer this earned reward points information to the user's universal account on the MyPoints™ server, i.e., the trading server; "Points for Loyalty": ¶ 6 – Issuing catalogers, i.e., reward points issuing entities, purchase points from MyPoints; therefore, they must maintain a balance of purchased points in order to account for how many reward points they possess to offer to users and to reconcile those already rewarded. This is especially important in order to reconcile points granted for off-line activities);

the user selecting an item for purchase from a merchant computer interconnected to the network (MyPoints™ Program web site: Page 8 – Points can be redeemed both on- and off-line for merchandise, travel, and services);

the merchant computer providing the item to the user in exchange for consideration received from said trading server (MyPoints™ Program web site: Page 8 – Points can be redeemed both on- and off-line for merchandise, travel, and services; "Points for Loyalty": ¶ 6);

the trading server reducing the number of points in the user's reward exchange account in accordance with the consideration provided to the merchant computer

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(MyPoints™ Program web site: Page 8 – Points can be redeemed both on- and off-line for merchandise, travel, and services);

in which the reward points issuing entities are selected from the group comprising an airline reward issuing entity, a credit and reward issuing entity, a hotel reward issuing entity, and a rental car reward issuing entity (MyPoints™ Program web site: Pages 17, 19-21 – Reward issuing entities include airlines and hotel chains);

in which the consideration provided to the trading server by the reward issuing entity has a value higher than the value of the user's earned reward points that are exchanged for said consideration ("Points for Loyalty": ¶ 6 – The cost of the points purchased from MyPoints™ by the issuers, i.e., the reward issuing entities, is \$0.016 per point while the redeemers only receive \$0.01 per point from MyPoints™; therefore, MyPoints™ makes a commission of \$0.006 per point. Essentially, the reduction of points in the user's account is higher than the number of points needed to pay for the requested item since the value of a point purchased by a reward issuing entity is higher than the value of the redeemed point. This results in the trading server, i.e., MyPoints™, receiving a commission on the exchange of user points for a purchased item);

in which the number of points in the user's reward exchange account is decreased by the number of points obtained by the trading system (MyPoints™ Program web site: Page 1 – Points are collected from different sources, on and off the Internet, and combined into one universal account; Pages 7-8 – Each web site decides how many points to offer to a user. Points may be provided either on- or off-line and are

processed overnight to be posted to the universal account on the following day in order to avoid fraudulent activity. This means that the points issued by the participant sites must be tracked at least long enough, e.g., in a user reward account, to transfer this earned reward points information to the user's universal account on the MyPoints™ server, i.e., the trading server; "Points for Loyalty": ¶ 6 – Issuing catalogers, i.e., reward points issuing entities, purchase points from MyPoints; therefore, they must maintain a balance of purchased points in order to account for how many reward points they possess to offer to users and to reconcile those already rewarded. This is especially important in order to reconcile points granted for off-line activities);

in which the reduction of points in the user's account [i.e., the reward exchange account] in the trading server is higher than the number of points needed to pay for the requested item whereby the trading server realizes a commission on the exchange of the user's points for the purchased item ("Points for Loyalty": ¶ 6 – The cost of the points purchased from MyPoints™ by the issuers, i.e., the reward issuing entities, is \$0.016 per point while the redeemers only receive \$0.01 per point from MyPoints™; therefore, MyPoints™ makes a commission of \$0.006 per point. Essentially, the reduction of points in the user's account is higher than the number of points needed to pay for the requested item since the value of a point purchased by a reward issuing entity is higher than the value of the redeemed point. This results in the trading server, i.e., MyPoints™, receiving a commission on the exchange of user points for a purchased item);

in which the user's accumulated reward points are used to pay for entertainment services (MyPoints™ Program web site: Page 16 – Points can be redeemed for entertainment);

wherein the item selected for purchase by the user has a discount associated therewith ("Points for Loyalty": ¶ 6).

Regarding claims 30-32, 35-38, 41, 43-52, MyPoints™ teaches a user reward account, yet MyPoints™ does not explicitly specify where this user reward account is stored before the user's point information is sent to the trading server. However, as addressed above, the reward points issuing entities must track a user's earned reward points at least long enough to communicate this point information to the trading server. This is especially important when reconciling points received for specific activities performed off-line as well as when assessing whether or not a reward points issuing entity has a sufficient balance of points to dole out reward points offered to users. The Examiner asserts that it is old and well-known in the art of data maintenance to store important data on an entity's server. This provides convenient access to such data from remote locations. Since a user's earned reward points information is important to the reward points issuing entities (e.g., for accounting and reconciliation purposes), the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention for the MyPoints™ participants (e.g., vendors, merchants, etc.) to store and track a user's earned reward points in a user reward point account on reward servers in order to provide a conveniently accessible means for

maintaining important accounting and reconciliation information regarding the reward points.

*Furthermore, it should be noted that, as per the claim language, the user only has to designate earned reward points from at least one reward point account (i.e., the user might only select one reward point account) for redemption purposes. MyPoints™ allows a user to redeem points accumulated from various reward points issuing entities; therefore, by selecting a product for which to redeem points, the user is essentially selecting at least one account, albeit only one account, from which points are to be redeemed.*

Additionally, while MyPoints™ is directed toward accumulating selected points from various individual reward accounts to be applied toward the purchase of a product and claims 30-32, 35-38, 41, and 43-52 of the instant application are directed toward accumulating selected points from various individual reward accounts to be applied toward the purchase of an item won during an auction, it is submitted that both auctions and purchasing products online are well-known forms of obtaining items that are to be paid for by a buyer. Furthermore, Official Notice is taken that it is old and well-known in the art that many auctions are conducted online, with payment being made online as well; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to accumulate selected points from various individual reward accounts to be applied toward the purchase of any product selected online (be it from an auction or other product source) in order to encourage use of the MyPoints™ rewards program by expanding the user's redemption options.

Regarding claims 35-37, MyPoints™ teaches the redemption of points for various merchandise, travel, or financial services ("Points for Loyalty": ¶ 5), including for airlines, hotels, and vacation cruises (MyPoints™ Program web site: Pages 17-21); however, MyPoints™ does not explicitly disclose the redemption of points for an item obtained from a manufacturer's overstocked inventory at a reduced price (claim 35), an item obtained from an inventory of timeshare properties available for exchange (claim 36), or an item obtained from duty free or other restricted access goods (claim 37). The Examiner asserts that it is old and well-known in the art of shopping for an entity to offer overstocked inventory at a reduced price, timeshare properties available for exchange, and duty free or other restricted access goods. MyPoints™ provides advertising and data gathering opportunities for any entity, especially those interested in offering their merchandise, travel, or financial services. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable MyPoints™ reward issuing entities to offer any merchandise, travel, or financial services they may be able to provide, including overstocked inventory at a reduced price, timeshare properties available for exchange, and duty free or other restricted access goods, to users of MyPoints™ in order to encourage patronage from a wider range of potential reward issuing entities and users, thereby increasing the likelihood of profit for the MyPoints™ Program.

[Claims 54-56, 58-61, 64, 66-69, 71-75] Claims 54-56, 58-61, 64, 66-69, 71-75 recite limitations already addressed by the rejection of claims 30-32, 35-38, 41, 43-52 above;

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therefore, the same rejection applies. Please note that MyPoints™ is an Internet-based system and therefore comprises various servers and computers. Further note the rejection of claim 54 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, stating that claim 54 recites various functionality that is not expressly performed by an element of the system; therefore, it is not clear that the functionality in question merits patentable weight in claim 54. For example, it is not clear which specific system element performs the functionality in (iii)(1), (iii)(2), and the whereby clause recited in the last seven lines of the claim.

6. Claims 33, 34, 57, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over the MyPoints™ Program, as disclosed in the following references:

Information about the MyPoints™ Program retrieved on July 26, 2002 from Internet <URL:<http://web.archive.org/web/19980128231040/http://www.mypoints.com>>, herein referred to as MyPoints™ Program web site. This web site was archived by web.archive.org on January 28, 1998.

Oberndorf, "Points for Loyalty," published December 1997.

Riedman, "MyPoints Aims to Be Universal Web Currency," published August 18, 1997, and as applied respectively to claims 31, 54, and 55 above, *in view of* Biorge et al. (U.S. Patent No. 5,806,045).

Regarding claims 33, 34, 57, and 70, MyPoints™ provides for the exchange of points for merchandise, travel, or financial services ("Points for Loyalty": ¶ 5) and even

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cash ("MyPoints Aims to Be Universal Web Currency": ¶ 7), yet it does not explicitly state that the purchase may be accomplished with a combination of points exchanged by the trading server *and other consideration provided by the user*, however, Biorge discloses an incentive program in which incentive credits are redeemed for discounts for a given transaction (col. 7, lines 14-29). This means that the user must provide a combination of incentive credits, i.e., points, in addition to the monetary balance of the transaction amount, i.e., other consideration, in order to complete the transaction. Like MyPoints™, Biorge provides an incentive program to its users, but Biorge also facilitates the added flexibility of allowing a user to exchange his/her incentive credits/points for a discount towards a transaction as opposed to a user having to wait until he/she accumulates enough points to pay for an item in full. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt MyPoints™ to enable users to redeem their points in combination with other consideration provided by the user (as taught by Biorge) in order to facilitate the added flexibility of allowing a user to exchange his/her incentive credits/points for a discount towards a transaction as opposed to a user having to wait until he/she accumulates enough points to pay for an item in full. For example, a user might want to use his/her balance of points towards vacation expenses (e.g., airfare, hotel, cruises, etc.); however, it would inconvenience the user to have to delay his/her trip until the adequate number of points to pay for the entire travel item is earned. By allowing the user to make up the monetary difference of his/her point balance and the exchange value of the

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travel item, the user has greater flexibility in utilizing his/her points (as evidenced by Biorge's incentive program), thereby encouraging further patronage from the user.

7. Claims 39, 40, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over the MyPoints™ Program, as disclosed in the following references:

Information about the MyPoints™ Program retrieved on July 26, 2002 from Internet <URL:<http://web.archive.org/web/19980128231040/http://www.mypoints.com>>, herein referred to as MyPoints™ Program web site. This web site was archived by web.archive.org on January 28, 1998.

Oberndorf, "Points for Loyalty," published December 1997.

Riedman, "MyPoints Aims to Be Universal Web Currency," published August 18, 1997, and as applied respectively to claims 30 and 54 above, *in view of* the Schlumberger Payflex card, as disclosed in the following references:

"World's First Smart Card Frequent Flyer Scheme Debuts," published September 19, 1997.

"Major Airlines Continue Their Smart Card Fly-bys," published January 1998.

"Schlumberger: AOM's Smart Card Frequent Flyer Program Successfully Launched," published May 22, 1998.

Regarding claims 39, 40, 62, and 63, MyPoints™ does not explicitly disclose the ability to transfer a user's accumulated reward points to a user's smart card with which the user may then make a direct purchase from a merchant. However, the

Schlumberger Payflex card makes up for this deficiency. The Schlumberger Payflex card is a smart card that stores user loyalty information for multiple retailers ("World's First Smart Card Frequent Flyer Scheme Debuts": ¶ 1). Loyalty points are accumulated on these smart cards; these points can be exchanged for free airline tickets, instant flight upgrades, car rentals, taxis, hotels, restaurants, entertainment, etc. ("World's First Smart Card Frequent Flyer Scheme Debuts": ¶ 2). Since both MyPoints™ and the Schlumberger Payflex card are directed toward customer loyalty programs and the ability to exchange points for goods and services, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt MyPoints™ to allow a user to download his/her accumulated reward points from the trading server to a smart card, such as the Schlumberger Payflex card, to make a direct purchase from a merchant with the stored accumulated reward points in order to expand MyPoints'™ base of participating merchants and attract more users, thereby increasing the likelihood of profit for the MyPoints™ Program.

8. Claims 42, 53, 65, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over the MyPoints™ Program, as disclosed in the following references:

Information about the MyPoints™ Program retrieved on July 26, 2002 from Internet <URL:<http://web.archive.org/web/19980128231040/http://www.mypoints.com>>, herein referred to as MyPoints™ Program web site. This web site was archived by web.archive.org on January 28, 1998.

Oberndorf, "Points for Loyalty," published December 1997.

Riedman, "MyPoints Aims to Be Universal Web Currency," published August 18, 1997, and as applied respectively to claims 30 and 54 above, *in view of* Walker et al. (U.S. Patent No. 6,128,599).

Regarding claims 42, 53, 65, and 76, MyPoints™ teaches a reward points accumulation and redemption program (as discussed above); however, MyPoints™ fails to explicitly disclose that the number of earned points in a given user's reward point account fluctuates as a function of the performance of the associated reward points issuing entity. Walker makes up for his deficiency with his teaching of "providing and managing a customized reward offer to an affinity group sponsor based on the aggregate performance of members of the group" (Abstract). For example, the higher the reward level attained, the greater the reward offered to an affinity group is (Columns 9-10, Table II). The performance of the entity offering the tiered rewards to an affinity group is affected by the goals achieved by the members of the affinity group; therefore, by providing higher reward levels for higher goals, the rewards provided by the reward issuing entity is effectively dependent on the performance of the entity. This is analogous to offering a number of earned points in a given user's reward point account that fluctuates as a function of the performance of the associated reward points issuing entity. Such a practice is deemed to encourage patronage from users, e.g., those in an affinity group (col. 1, line 59 through col. 2, line 9). Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide MyPoints™ users with a number of earned points in a given user's

reward point account that fluctuates as a function of the performance of the associated reward points issuing entity (the concept of which is taught by Walker) in order to encourage patronage from users, thereby increasing the likelihood that participating merchants will benefit from the MyPoints™ Program.

***Allowable Subject Matter***

9. Claims 30-76 would be allowable if rewritten or amended to overcome the rejections under Double Patenting and 35 U.S.C. § 112, second paragraph, set forth in this Office action, AND amended to clarify that the user ***actively selects a subset of points from two or more individual reward accounts at the time of redemption***. As they currently stand, claims 30-76 essentially read on a user having access to all of his/her reward accounts (e.g., accessing different web sites corresponding to different loyalty programs through the same terminal) and then selecting one account from which to redeem points.

10. If amended accordingly, claims 30-76 would be deemed allowable for the following reasons.

The following references have been identified by the Examiner as the closest prior art of record:

(1) MyPoints™ Program, as disclosed in the following references:

(a) Information about the MyPoints™ Program retrieved on July 26, 2002  
from Internet

<URL:<http://web.archive.org/web/19980128231040/http://www.mypoints.com>>, herein referred to as MyPoints™ Program web site. This web site was archived by web.archive.org on January 28, 1998.

(b) Oberndorf, "Points for Loyalty," published December 1997.

(c) Riedman, "MyPoints Aims to Be Universal Web Currency," published August 18, 1997.

(2) Biorge et al. (U.S. Patent No. 5,806,045).

(3) Schlumberger Payflex card, as disclosed in the following references:

(a) "World's First Smart Card Frequent Flyer Scheme Debuts," published September 19, 1997.

(b) "Major Airlines Continue Their Smart Card Fly-bys," published January 1998.

(c) "Schlumberger: AOM's Smart Card Frequent Flyer Program Successfully Launched," published May 22, 1998.

(4) Walker et al. (U.S. Patent No. 6,128,599).

Similar to the claimed invention, the MyPoints™ Program is a reward points accumulation and redemption program. Also, the MyPoints™ Program allows a user to gather points from different reward points issuing entities. Then all gathered points are accumulated in a universal account from which points may be redeemed through a trading server. However, unlike the claimed invention, MyPoints™'s users do not have control over which of a subset of reward points are accumulated in the universal

account; all MyPoints™'s reward points are accumulated in the universal account regardless of which reward points issuing entity issued the reward points. Biorge discloses an incentive program in which incentive credits are redeemed for discounts for a given transaction (col. 7, lines 14-29). The Schlumberger Payflex card is a smart card that stores user loyalty information for multiple retailers ("World's First Smart Card Frequent Flyer Scheme Debuts": ¶ 1). Loyalty points are accumulated on these smart cards; these points can be exchanged for free airline tickets, instant flight upgrades, car rentals, taxis, hotels, restaurants, entertainment, etc. ("World's First Smart Card Frequent Flyer Scheme Debuts": ¶ 2). Walker teaches the concept of "providing and managing a customized reward offer to an affinity group sponsor based on the aggregate performance of members of the group" (Abstract).

However, neither the MyPoints™ Program nor any of the other aforementioned references teaches or suggests the novel aspects of the claimed invention which allow a user to maintain a plurality of individual reward accounts and then selectively choose how many of a subset of reward points and from which two or more individual reward accounts are to be applied toward purchase of a selected product via a reward points trading system.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 30-76 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-58 of copending Application No. 10/608,736. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 30-58 of Application No. 10/608,736 are directed toward accumulating selected points from various individual reward accounts to be applied toward the purchase of a product selected online while claims 30-76 of the instant application are directed toward accumulating selected points from various individual reward accounts to be applied toward the purchase of an item won during an auction. Both auctions and purchasing products online are well-known forms of obtaining items that are to be paid for by a buyer. Furthermore, it is old and well-known that many auctions are conducted online, with payment being made online as well; therefore, the Examiner asserts that, in light of the claimed invention in Application No. 10/608,736, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to accumulate selected points from various individual reward accounts to be applied toward the purchase of any product selected online (be it from an auction or other product source) in order to encourage use of the claimed rewards program by expanding the user's redemption options.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 30-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 6,594,640. Although the conflicting claims are not identical, they are not patentably distinct from each other because both auctions and online redemption programs are well-known forms of obtaining items that are to be paid for by a buyer. Furthermore, it is old and well-known that many auctions are conducted online, with payment being made online as well; therefore, the Examiner asserts that, in light of this common knowledge, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to accumulate selected points from various individual reward accounts to be applied toward the purchase of any product selected online (be it from an auction or other product source) in order to encourage use of the claimed rewards program by expanding the user's redemption options.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. Please note that all references marked with an asterisk on the attached PTO Form 892 are not being provided to Applicant since Applicant was already supplied with a copy of each marked reference in parent Applicant No. 09/602,222.

Blagg (US 2003/0182218) -- Discloses the ability to pool reward points held in various related accounts (¶¶ 175-184).

Helbig (US 2002/0116257) -- Discloses an online incentive program.

Anderson et al. (WO 01/01278 A2) -- Discloses a server-based system for monitoring points across various loyalty programs and allowing a user to redeem and convert points.

"Transmedia Europe, Inc. and Transmedia Asia Pacific, Inc. Announce the Acquisition of a Silicon Valley Internet Loyalty and Member Benefit Provider" -- Discloses Award Track, Inc.'s server-based system for monitoring points across various loyalty programs and allowing a user to redeem and convert points.

Eggleston et al. (U.S. Patent No. 6,061,660) -- Discloses an incentive program customized to each retailer's needs.

Walker et al. (U.S. Patent No. 6,049,778) -- Discloses an incentive program in which rewards are granted based on a product's success.

Fredregill et al. (U.S. Patent No. 5,923,016) -- Discloses an in-store points redemption program.

Ferguson et al. (U.S. Patent No. 5,991,736) -- Discloses an incentive program that credits a monetary award to a customer's retirement account.

Messner (U.S. Patent No. 6,370,514 B1) -- Discloses a method for marketing and redeeming vouchers for use in online purchases.

Paltenghe et al. (EP 0 917 120 A2) -- Discloses a virtual wallet system in which a smart card can be a proxy to a wallet server where currency is stored.

"Chip Cards Get a Loyal Corporate Following" – Discloses a smart card loyalty points program.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

or faxed to:

**(703)305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.

*Susanna Diaz*  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
March 19, 2004